

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 13-19 remain pending in the present Application.

The Office Action rejects Claims 13-19 under 35 U.S.C. § 101; objects to the Summary of the Invention; and rejects Claims 13-19 under 35 U.S.C. § 112, second paragraph.

REJECTION UNDER 35 U.S.C. § 101

The Official Action rejects Claims 13-19 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant respectfully traverses the rejection.

Applicant notes that Claims 13, 14, and 17 are directed to an image displaying apparatus and recite means-plus-function terminology.

Proper claim interpretation of a means-plus-function (35 U.S.C. § 112, 6th paragraph) element entails consideration of the structures disclosed in the specification and equivalents thereof.

In determining the scope of the claims prior to determining compliance with each statutory requirement for patentability, MPEP § 2106 provides:

Office personnel are to correlate each claim limitation to all portions of the disclosure that describes the claim limitation. This is to be done in all cases, i.e., whether or not the claimed invention is defined using means or step plus function language. The correlation step will ensure that office personnel will correctly interpret each claim limitation. (emphasis added).

Thus, Applicant respectfully submits that the rejection under 35 U.S.C. § 101 of at least Claims 13, 14, and 17 are improper as these claims clearly recite apparatus claim limitations.

With regard to Claims 15, 16, 18, and 19, MPEP § 2106 further provides that:

Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitations to a practical application in a

technological arts should it be rejected under 35 U.S.C. § 101 . . . Further, when such a rejection is made, office personnel must expressly state how the language of the claims has been interpreted to support the rejection. (emphasis added) See MPEP § 2106.

The rejection merely states that “applicant presents no ‘substance’ upon which claimed invention acts and on this basis its [sic] believed that invention represents a purely an abstract idea.”¹ Thus, Applicant respectfully submits that no express statement has been provided as to how the language of the claims has been interpreted to support the 35 U.S.C. § 101 rejection in violation of the guidelines of MPEP § 2106.

Accordingly, should such a rejection be maintained in a subsequent communication with respect to any of the aforementioned claims, Applicant respectfully requests the Examiner provide an express statement on the record in accordance with MPEP § 2106 guidelines explaining how such claim terminology, such as “displaying icons,” “image information displaying area,” “position information displaying area,” “changing display of icons,” “storing image data,” and “display control means,” is interpreted. More specifically, how such limitations are deficient to define a practical application in the technological arts of useful, concrete and tangible result.²

Accordingly, Applicant respectfully requests that the rejection of Claims 13-19 under 35 U.S.C. § 101 be withdrawn.

OBJECTION TO THE SUMMARY OF THE INVENTION

The Office Action objects to the Summary of the Invention “because it recites identical claim language.”³ Applicant respectfully traverses the objection.

As the Office Action states, “the summary is separate and distinct from the abstract and

¹ Office Action of September 15, 2004, page 2.

² See State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368, 1374, 47 (Fed. Cir. 1998) (discussing practical application of a mathematical algorithm, formula, or calculation.).

³ Office Action of September 15, 2004, page 2.

is directed toward the invention rather than the disclosure as a whole.”⁴ However, Applicant notes that no rule sets forth that the Summary of the Invention must not recite language appearing in the claims.

Accordingly, Applicant respectfully requests that the objection be withdrawn. Should the objection be maintained in a subsequent communication, Applicant respectfully requests the Examiner identify a relevant portion of the MPEP which supports the rejection based upon the use of claim language so that Applicant may have the opportunity to reply completely.

REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

The Office Action rejects Claims 13-19 under 35 U.S.C. § 112, second paragraph. Applicant respectfully traverses the rejection.

In rejecting claims under 35 U.S.C. § 112, second paragraph, MPEP § 2173.02 provides:

If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. § 112, second paragraph is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is “vague and indefinite” should be included in the Office Action. (emphasis added) See MPEP § 2173.02

The rejection merely includes the conclusory statement “Claims 13-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.”⁵ Accordingly Applicant respectfully requests that the rejection be withdrawn. Should the rejection be maintained in a subsequent communication, Applicant respectfully requests the Examiner provide an express analysis as to specific claim language used in Claims 13-19 believed to be “vague and indefinite” so that Applicant may have the opportunity to reply completely.

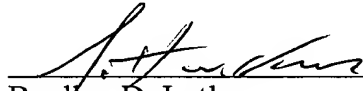
⁴ Office Action of September 15, 2004, page 3, citing MPEP § 608.01(d).

⁵ Office Action of September 15, 2004, page 5.

Accordingly, in view of the foregoing amendments and remarks, it is respectfully submitted that the present application, including Claims 13-19, is statutory, definite, in condition for allowance, and such action is respectfully requested at an early date.

Respectfully submitted,

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